

REMARKS

I. Introduction

At the time of the Office Action dated August 30, 2005, claims 1-12 were pending. Of those claims, claims 8-12 have been withdrawn from consideration pursuant to the provisions of 37 C.F.R. §1.142(b) and therefore cancelled. Applicant acknowledges, with appreciation, the Examiner's indication that claim 4 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 1-3 and 5-7 stand rejected.

In this Amendment, claims 2, 3 and 5-7 have been amended, claims 1 and 4 have been canceled, without prejudice, and new claim 13 has been added. Care has been exercised to avoid the introduction of new matter. Claim 13 corresponds to claim 4 written in independent format including all the limitations recited in original claims 1 and 4, although the wording of the claim has been slightly revised so as to address the rejection of claim 1 under 35 U.S.C. §112, second paragraph. Claims 2, 3 and 5-7 have been amended to be dependent on new claim 13.

II. The Rejection of Claim 1 under 35 U.S.C. §112, Second Paragraph

The Examiner pointed out that the terms "respective performances" and "types," and the "third step predicting performance" are indefinite. In response, Applicant has canceled claim 1, and added new claim 13, which addresses the issues raised by the Examiner in the 35 U.S.C. §112 rejection.

Applicant submits that new claim 13 is definite and that a person skilled in the art would readily understand the claim in light of the specification (e.g., page 5, line 24 to page 6, line 25;

and page 7, lines 12-20). Withdrawal of the rejection of claim 1 under 35 U.S.C. §112, second paragraph is respectfully solicited.

III. The Rejection of Claims 1-3 and 5-7 under 35 U.S.C. §102(e)

In the statement of the rejection, the Examiner asserted that Voorakaranam et al. discloses an apparatus for low cost signature testing for analog and RF circuits identically corresponding to what is claimed.

In response, it is noted that this rejection of claims 1-3 and 5-7 has been rendered moot by cancellation of claim 1 and the amendment of claims 2, 3 and 5-7 to be dependent on new claim 13. Withdrawal of this rejection is respectfully solicited.

IV. New Claim 13

It is submitted that new claim 13 is patentable at least because it includes all the limitations recited in claim 4 which is indicated to be allowable by the Examiner. Dependent claims 2, 3 and 5-7 are also patentable at least because they respectively include all the limitations recited in independent claim 13. Applicant respectfully solicits favorable consideration of claims 2, 3 and 5-7 and 13.

V. Conclusion

It should, therefore, be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

Application No.: 10/627,641

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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